



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,212	01/19/1999	JEFFREY ALLEN JONES	AT9-98-567	2081

35525 7590 05/14/2004

DUKE W. YEE  
CARSTENS, YEE & CAHOON, L.L.P.  
P.O. BOX 802334  
DALLAS, TX 75380

EXAMINER
----------

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
----------	--------------

2155

*22*

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Supplemental Office Action Summary

Application No.

09/232,212

Applicant(s)

JONES ET AL.

Examiner

Young N Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on March 15, 2004
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 21-38 have been examined and are pending with this action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 21-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. (US 5,815,657 A).

Independent:

As per claims 21, 27, and 33, Williams teaches a method, an apparatus, and a computer program product in a computer-readable medium for communicating over Internet (see col.9, lines 30-32) comprising: responsive to receipt of a signal to transmit information from the Internet processor (see col.8, lines 7-13) over an established Internet connection, identifying at least one information element within the information to be transmitted (see Fig.10; Fig.21; and col.11, lines 5-10, 24-30 & 53-63); generating a message (see col.11, line 6: "browser launches" and col.13, lines 31-36: "GUI components for wallet creation"), wherein the message presents the at least one information element (see col.12, lines 35-40; col.14, line 62 – col.15, line 4; and col.21, lines 25-32) and includes a cancel control (see Fig.10, #1010; Fig.11, #1150; Fig.15, #1595; Fig.16, #1695; Fig.17, #1746) for canceling transmission (see col.2, line 66 – col.3, line 7); and responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection (see Fig.13 and col.31, lines 18-20).

Dependent:

As per claims 22, 28, and 34, Williams further teaches wherein the message includes a selection control for each information element disclosed in the message (see Fig.10; Fig.11; Fig.14; Fig.21; col.18, line 65 - col.19, line 3; col.22, lines 17-19; and col.31, lines 28-40).

As per claims 23, 29, and 35, Williams further teaches wherein each selection control is selected by default (see col.18, lines 16-19).

As per claims 24, 25, 30, 31, 36, and 37, Williams teach of further comprising: responsive to deselection of a selection control (see col.22, lines 32-36), blocking transmission of the information element corresponding to the selection or deselection control (see col.38, line 6-12: only what has been selected is transmitted). **Note:** what is transmitted and not transmitted resulted by selection or deselection is a matter of programming. This limitation is subjective and does not patentably distinguish the claimed invention. Williams clearly teaches of enabling the user to choose what is transmitted and what is not.

As per claims 26, 32, and 38, Williams further teaches wherein the message presents the address of the Internet server to which the information is to be transmitted (see col.13, lines 45-47: "merchant URL").

### ***Response to Arguments***

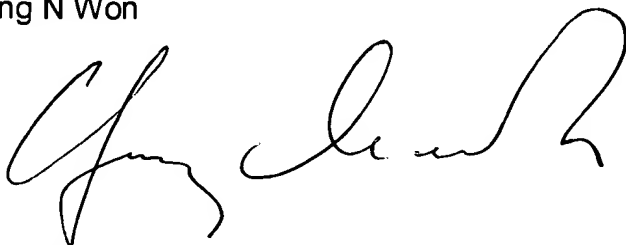
3. Applicant's arguments with respect to claims 21-38 have been considered but are moot in view of the new ground(s) of rejection.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Young N Won



May 6, 2004



**HOSAIN ALAM**  
**SUPERVISORY PATENT EXAMINER**